

Remarks/Arguments

A. Pending Claims

Claims 36-75 are currently pending. Claims 36 and 61 have been amended. The claims have been amended for clarity. Claims 71-75 are new.

B. Telephone Conference

Applicant's representatives David W. Quimby and Russell E. Henrichs had a telephone conference with the Examiner on December 4, 2003. The discussion concerned indefiniteness rejections and obviousness rejections of the claims. Applicant and Applicant's representatives thank the Examiner for his time and consideration.

C. The Claims Are Not Indefinite Pursuant to 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 36-70 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully disagrees with the rejection with respect to claim 36, but Applicant has amended claim 36 for further clarification. Applicant respectfully requests the Examiner withdraw the rejection of claim 36 and the claims dependent thereon.

The Examiner rejected claims 51-60 as "being incomplete for omitting essential steps, such omission amounting to a gap between the steps (Office Action, pages 4-5)." Applicant respectfully reminds the Examiner, according to MPEP 2173.02:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level skill in the pertinent art at the time the invention was made.

The Examiner states that one or more steps related to “determining whether a portion of received data includes values in a list of allowable values”, “flattening data” and “transferring the data” are required. Applicant respectfully submits that a person possessing the ordinary level of skill in the pertinent art with the Applicant’s specification would have reasonable notice as to the scope of the claims. Applicant respectfully requests removal of the rejection of claim 51 and the claims dependent thereon.

The Examiner rejected claims 61-70 because “the outcome of the determination has no relationship to the any limitation(s) that follows (Office Action, page 5).” Applicant respectfully disagrees, but Applicant has amended the claims for further clarification. Applicant respectfully requests the Examiner withdraw the rejections of claims 61-70.

D. The Claims Are Not Obvious Over McDonough In View of Thorne Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 36-70 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,115,693 to McDonough et al. (hereinafter “McDonough”) and further in view of U.S. Patent No. 6,100,891 to Thorne (hereinafter “Thorne”). Applicant respectfully disagrees with the rejections.

To reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (emphasis added) *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03. In response to this assertion, the Examiner states:

As to the applicant’s argument that “to establish a *prima facie* obviousness of a

claimed invention, all the claim limitations must be taught or suggested by the prior art, the Examiner respectfully points out that applicant has not considered the requirement in its entirety. The requirement clearly states that **“there must be some suggestion or motivation or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings”**.

Applicant respectfully points out that **both** parts of the requirement must be met by the Examiner. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

Neither McDonough nor Thorne, either separately or when combined, appears to disclose, teach, or suggest “the middleware program determines whether portions of the received data include allowable values based on the domain file” as recited in claim 36. The Examiner states this is inherent in McDonough and taught by Thorne. Applicant asserts these features are not inherent in McDonough. For example, McDonough does not even disclose a domain file. Furthermore, Thorne only appears to disclose assigning “a list of allowable values to each element (Thorne, col. 6, line 23-24).” Thorne does not appear to teach or suggest using this list of allowable values against received data, but instead teaches using the list of allowable values in an interface program. In addition, because Thorne teaches using the list of allowable values in an interface program, one of ordinary skill in the art combining Thorne and McDonough would be taught to put Thorne's list of available values in McDonough's interface program, not the Context Manager of McDonough. The Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to implement the aforementioned feature in the middleware (the context manager) of McDonough, since it has been held that rearranging parts of an inventions involves only routine skill in the art. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). (Office Action, page 8).

Applicant's respectfully point out that putting the domain file in the middleware provides a substantial advantage over having a domain file in the interface program. For example, because the domain file is accessible by the middleware, different interface programs used with the invention do not have to be rewritten or modified to incorporate the domain file. Instead, the middleware may be used with multiple interface programs because the domain file is accessed from the middleware. Applicant respectfully requests removal of the rejection of claim 36 and the claims dependent thereon.

Claims 51 and 61 and claims 52-60 and 62-70 dependent on claims 51 and 61, respectively, include similar limitations not disclosed by McDonough or Thorne. Applicant, therefore, respectfully requests the Examiner withdraw the rejections as to claims 51-70.

In addition, Applicant also submits that while there may be motivation to combine McDonough and Thorne to provide a system that provides a script from Thorne to a Context Manager selected employee of McDonough, there is no motivation or suggestion that the list of allowable values in Thorne be incorporated into the Context Manager of McDonough to determine whether portions of received data include the allowable values. For example, there is no teaching in McDonough to suggest that a customer access resource may submit an anomalous data element in a request to the Context Manager. Therefore, Applicant asserts that there is no motivation to incorporate a list of allowable values in McDonough for a middleware program to use to determine whether portions of the received data include allowable values. Applicant requests removal of the obviousness rejections of the claims.

E. New Claims

Applicant submits that new claims 71-75 do not appear to be taught or suggested by the

cited art and do not add new subject matter to the application. Applicant requests allowance of claims 71-75.

F. Additional Remarks

Applicant submits that all claims are in condition for allowance. Favorable consideration is respectfully requested.

If an extension of time is needed, Applicant requests the appropriate extension of time. A fee authorization is enclosed for additional claims fees. If any other fees are required, please charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-30700/EBM.

Respectfully submitted,



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